

BoxInterferences@uspto.gov
Telephone: 571-272-4683

Paper 108
Entered: 1 February 2010

UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

Patent Interference 105,685 McK
Technology Center 1600

WYETH

(Named inventors: Anthony F. Hadfield, Syed M. Shah,
James A. Provost, Aeri Park, Rex A. Shipplett,
Brenton W. Russell, and Beat T. Weber),
Patents 6,673,838 B2 and 7,291,347 B2,

Junior Party,

v.

SEPRACOR, INC.

(Named inventors: Thomas P. Jerussi, Chrisantha H. Senanayake,
and Nandkumar N. Bhongle)
Applications 10/720,134, 11/091,518 and 12/011,083,

Senior Party.

Before: Fred E. McKelvey, *Senior Administrative Patent Judge*.

SECOND REDECLARATION OF INTERFERENCE

In order to conform the interference to the various decisions on
motions, the interference is redeclared as follows.

1. Sepracor is made senior party and Wyeth is made junior party.
2. In filing future papers, the parties should use the heading set out
above.

1 Jerussi: Application 09/527,442,
2 filed 17 March 2000
3
4 Application 10/720,134
5 filed 25 November 2003
6
7 Provisional application 60/127,938,
8 filed 6 April 1999
9
10 Provisional application 60/167,906
11 filed 30 November 1999
12 4. Count 6 remains as follows:
13 Count 6
14 An oral dosage form comprising O-desmethyl
15 venlafaxine succinate, wherein the oral dosage form is a tablet
16 or capsule.
17 The claims of the parties are:
18 Jerussi '083: 60-63
19 Hadfield '347: 1-9
20 The claims that correspond to Count 6 are:
21 Jerussi '083: 60-63
22 Hadfield '347: 1-9
23 The claims that do not correspond to Count 6 are:
24 Jerussi '083: None
25 Hadfield '347: None
26 With respect to Count 6, the parties are accorded an earlier
27 constructive reduction to practice (*i.e.*, benefit for the purpose of priority) of
28 the following applications:

1 Hadfield: Provisional application 60/268,214
2 filed 12 February 2001

3
4 Provisional application 60/297,963
5 filed 13 June 2001

6
7 Jerussi: Application 09/527,442,
8 filed 17 March 2000

9
10 Application 10/720,134
11 filed 25 November 2003

12
13 Provisional application 60/127,938,
14 filed 6 April 1999

15
16 Provisional application 60/167,906
17 filed 30 November 1999

18 5. Count 7 remains as follows:

19 Count 7

20 The composition of claims 23, 25 or 26 of

21 Hadfield U.S. Patent **6,673,838 B2**

22 or

23 the composition of claims 1 or 64 of Jerussi application **11/091,518**

24 or

25 the composition and dosage form claims 63-65 of

26 Jerussi application **10/720,134**.

27
28 Hadfield claim 23 reads:

29 A pharmaceutical composition comprising O-desmethyl
30 venlafaxine succinate and a pharmaceutically acceptable carrier
31 or excipient.

1 Hadfield claim 25 reads:

2 A pharmaceutical dosage form comprising a therapeutically
3 effective amount of O-desmethyl venlafaxine succinate and a
4 pharmaceutically acceptable carrier or excipient.

5 Hadfield claim 26 reads:

6 An oral dosage form comprising a therapeutically effective
7 amount of O-desmethyl venlafaxine succinate and a
8 pharmaceutically acceptable carrier or excipient.

9 Jerussi claim 1 of application 11/091,518 reads:

10 A pharmaceutical composition which comprises
11 (±)-O-desmethylvenlafaxine succinate and a pharmaceutically
12 acceptable carrier or excipient, wherein (±)-O-
13 desmethylvenlafaxine is present at an amount of about 50 mg.

14 Jerussi claim 64 of application 11/091,518 reads:

15
16 A pharmaceutical composition which comprises
17 (±)-O-desmethylvenlafaxine succinate and a pharmaceutically
18 acceptable carrier or excipient, wherein (±)-O-
19 desmethylvenlafaxine is present at an amount of about 100 mg.

20 Jerussi claim 63 of application 10/720,134 reads:

21
22 A pharmaceutical composition comprising a therapeutically
23 effective amount of O-desmethylvenlafaxine succinate and a
24 pharmaceutically acceptable carrier or excipient.

1 Jerussi claim 64 of application 10/720,134 reads:

2
3 A pharmaceutical dosage form comprising a therapeutically
4 effective amount of O-desmethylvenlafaxine succinate and a
5 pharmaceutically acceptable carrier or excipient.

6 Jerussi claim 65 of application 10/720,134 reads:

7
8 An oral dosage form comprising a therapeutically effective
9 amount of O-desmethylvenlafaxine succinate and a
10 pharmaceutically acceptable carrier or excipient.

11
12 The claims of the parties are:

13 Hadfield '838: 1-46
14 Jerussi '518: 1, 12 and 60-69
15 Jerussi '134: 60-71

16 The claims that correspond to Count 7 are:

17 Hadfield '838: 23-34 and 46
18 Jerussi '518: 1, 12 and 60-69
19 Jerussi '134: 63-71

20 The claims that do not correspond to Count 7 are:

21 Hadfield '838: 1-22 and 35-45
22 Jerussi '518: None
23 Jerussi '134: 60-62

24 With respect to Count 7, the parties are accorded an earlier
25 constructive reduction to practice (*i.e.*, benefit for the purpose of priority) of
26 the following applications:

27 Hadfield: Provisional application 60/268,214
28 filed 12 February 2001
29

| | | |
|----|----------|-------------------------------------|
| 1 | | Provisional application 60/297,963 |
| 2 | | filed 13 June 2001 |
| 3 | | |
| 4 | Jerussi: | Application 09/527,442, |
| 5 | | filed 17 March 2000 |
| 6 | | |
| 7 | | Application 10/720,134 |
| 8 | | filed 25 November 2003 |
| 9 | | |
| 10 | | Provisional application 60/127,938, |
| 11 | | filed 6 April 1999 |
| 12 | | |
| 13 | | Provisional application 60/167,906 |
| 14 | | filed 30 November 1999 |

1 105,685
2 (via electronic mail):
3 Attorney for Sepracor, Inc.):

4
5 Thomas E. Friebe, Esq.
6 Jones Day
7 222 East 41st Street
8 New York, NY 10017

9
10 Tel: 212-326-3939
11 Fax: 212-755-7306
12 Email: tefriebe@jonesday.com

13
14 Anthony M. Insogna, Esq.
15 Jones Day
16 12265 El Camino Real, Suite 200
17 San Diego, CA 92130

18
19 Tel: 858-314-1200
20 Fax: 858-314-1150
21 Email: aminsogna@jonesday.com

22
23 Attorney for Wyeth:

24
25 Steven P. O'Connor, Esq.
26 FINNEGAN, HENDERSON, FARABOW,
27 GARRETT & DUNNER L.L.P.
28 11955 Freedom Drive
29 Reston, VA 20190-5675

30
31 Tel: 571-203-2718
32 Fax: 202-408-4400
33 Email: steven.oconnor@finnegan.com

34

1 Carlos M. Téllez, Esq.
2 FINNEGAN, HENDERSON, FARABOW,
3 GARRETT & DUNNER L.L.P.
4 901 New York Avenue, NW
5 Washington, D.C. 20001-4413
6
7 Tel: 202-408-4123
8 Fax: 202-408-4400
9 Email: carlos.tellez@finnegan.com
10
11